REMARKS

This amendment is responsive to the Office Action dated July 10, 2001. Claims 1-10, 15-30 and 42-47 have been cancelled. Pending claims 11-14, and 35-37 have been amended. New claims 48-72 has been added. Reconsideration of the objections and rejections contained in the Office Action is hereby requested.

1. Request for Information Under 37 CFR 1.105

The Office Action requested certain information under 37 CFR 1.105. Attached to this Amendment is a Disclosure Under 37 CFR 1.105 in compliance with the request.

2. Double Patenting

Claims 1-30 and 42-47 were rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-21 of United States Patent No. 6,219,694, from which this present application is a continuation. A terminal disclaimer is attached to this Amendment in order to overcome the double patenting rejection.

3. Rejections Under Section 112

Claims 35-37 were rejected under section 112, first paragraph. These claims have now been amended to overcome this rejection. Support for the amendments is set forth at page 8 of the present application.

4. Rejections Under Sections 102 and 103

A. Summary of Rejections

Claims 1-3, 6, 9, 10, 16, 24-30 and 42-46 were rejected under section 102 as being anticipated by United States Patent No. 5,764,639 to Staples ("Staples"). Claim 23 was rejected under section 103 as being obvious over Staples. Claims 17-22 were rejected under section 103 as being obvious over Staples in view of United States Patent No. 6,073,16 to Narasimhan. Claims 4, 5, 7-8, 15 and 47 were rejected as being obvious over Staples in view of United States Patent No. 6,052,735 to Ulrich ("Ulrich"). Claims 31, 32, 34, 37, 38 and 41 were rejected as being anticipated by Ulrich. Claims 33, 35-37 and 39-40 were rejected as being obvious over Ulrich. And claims 1, 2, 9, and 11-14 were rejected as being obvious over Ulrich in view of United States Patent No. 6,034,621 to Kaufman ("Kaufman").

For purposes of this Amendment, there are three groups of claims. The claims in Group I are claims 1-3, 6, 9, 10, 16-30 and 42-46 ("the Group I Claims"). The Group I Claims were rejected in view of Staples (alone or in combination) under sections 102 and 103. The claims in Group II are claims 11-14 and 31-41 ("the Group II Claims"). The Group II Claims were NOT rejected over Staples, but only were rejected in view of Ulrich (alone or in combination) under sections 102 and 103. And the claims in Group III are claims 4, 5, 7-8, 15 and 47 ("the Group III Claims.") The Group III Claims were rejected over Staples in view of Ulrich. The list below summarized the claim groupings and prior art rejections:

Claim Group	Claims	Primary Reference
Group I Claims	1-3, 6, 9, 10, 16-30 and 42-46	Staples
Group II Claims	11-14 and 31-41	Ulrich
Group III Claims	4, 5, 7-8, 15 and 47	Staples & Ulrich

All of the claims in Groups I and III have now been canceled by this Amendment. Further discussion of these claims is therefore unnecessary. The only remaining claims at issue in this application are the Group II Claims, which were only rejected over Ulrich and Kaufmann, and the new claims 48-72. These claims are in condition for allowance for the reasons set forth below.

B. Ulrich and Kaufman are Not Prior Art

The Group II Claims were rejected primarily over Ulrich. These claims were NOT rejected over Staples, and thus Staples is not an issue with respect to the patentability of these claims. (MPEP § 707.07(g)) Some of these claims were rejected only in view of Ulrich, and other were rejected in view of Ulrich in combination with Kaufman. These rejections are respectfully traversed.

Ulrich and Kaufman are NOT prior art to the present application. Attached to this Amendment is an Affidavit under 37 CFR 1.131, which establishes that the present invention was conceived of prior to the earliest effective filing dates of either Ulrich or Kaufman, and that the inventors then diligently worked towards reducing their invention to practice and filing the parent application to this application. Therefore, the rejections

of the Group II Claims must be withdrawn. Since there are no remaining rejections of these claims, an indication of allowability is respectfully requested.

C. Staples Does Not Anticipate or Render Obvious The New Claims

The Group I Claims were rejected primarily over Staples. In rejecting these claims, the Patent Office primarily relies on a portion of the Staples patent that indicates that a remote user can establish a "virtual presence" at their corporate office so that the remote user can send and receive phone calls, faxes, email, etc., "as if he were physically present at the corporate office." (Staples, col. 6, ll. 20-40; col. 23, ll. 2-13) The methodology described in Staples, however, is dramatically different from the system and method described in the present application. In fact, Staples is just another example of a "pull synchronization" system, in which the remote user must connect to the host system in order to obtain any relevant information stored at the host system, and once disconnected, is no longer synchronized with the host. These types of systems, and there shortcomings, were discussed in detail in the Background section of the present application. These rejections are respectfully traversed.

Because the Group I Claims have been canceled, further discussion of these claims with respect to Staples is unnecessary. New claims 48-72, however, are based, in part, on original claim 1, and therefore a discussion of these claims with respect to Staples is deemed necessary under 37 CFR 1.111. This discussion, which is set forth below, demonstrates that these claims are patentably distinguishable from Staples.

i. The Staples System

Staples discloses a system and method for providing a remote user with a virtual presence to an office so that the remote user can behave substantially as if the user were physically present at the corporate office. (Abst.) This is accomplished using "virtual presence" software operating at the remote device, and at something called a "virtual presence server." (Abst.; FIG. 2) The virtual presence server (106) is then coupled to various other systems at the corporate office, such as a PBX system (112) for receiving phone calls, and the corporate LAN (114) for receiving data. (Abst.; FIG. 2)

Staples discloses only one method for achieving this "virtual presence" -- by causing the remote device to dial into and create a "connection" to the virtual presence server. (Staples, col. 2, ll. 38-49):

> "When the remote user desires to establish a virtual presence at the corporate office, *the remote user dials the virtual presence server and establishes a connection. This includes providing identification information and security information to the virtual presence server.* Once the remote user is connected, the virtual presence server instructs the corporate PBX to automatically forward all calls to the remote user. The virtual presence server also routes email, faxes, and LAN data to the remote user." (emphasis added)

Without this "connection" being established between the remote device and the virtual presence server, there is no viewing of information at the remote device. Thus, like the "pull synchronization" systems described in the Background section of the present application, "the two systems (host and mobile) only maintain the same data items after a user-initiated command sequence that causes the mobile device to download the

data items from the host system." (Background, at 3)

The requirement of a "connection" between the remote device and the virtual presence server is described throughout Staples:

> "First the remote user establishes a virtual presence at the corporate office, including providing identification and security. *Once the remote user is connected, the virtual presence server instructs the corporate PBX to automatically forward all calls to the remote user.*" (Abstract; emphasis added)
>
> "The user [at the remote unit] preferably clicks the mouse on the 'Be There' icon *to establish a connection between the remote computer system and the corporate office.* Clicking the mouse button on the 'Be There' icon invokes an autodial routine, and the autodial routine operates *to provide a connection between the remote computer system and the corporate office.*" (Col. 17, lines 1-7; emphasis added)
>
> "In step 568 the virtual presence software establishes a connection with the virtual presence server." (Col. 21, ll. 8-10)
>
> "Therefore, *once the remote user has been connected to the corporate office,* the remote user operates substantially as if the user were physically present at the corporate office." (Col. 23, ll. 30-32)

Put simply, Staples is describing a remote login and control system for a remote device so that the user of the remote device can gain access to information at their corporate office.

ii. <u>New Claims 48-72 are Patentable over Staples</u>

New independent claims 48 and 72 are based, in part, on original claim 1. Claim 48 provides a method redirecting data items between a messaging server and a plurality of mobile communication devices. The claimed method includes the following steps: (A) receiving data items directed to a plurality of e-mail addresses associated

with user accounts maintained by the messaging server; (B) for each of the plurality of mobile communication devices, receiving a trigger signal at the messaging server that enables data item redirection, wherein the trigger signals are transmitted to the messaging server from a plurality of desktop systems associated with the plurality of mobile communication devices; (C) for each of the plurality of mobile communication devices for which a trigger signal has been received at the messaging server, continuously redirecting data items from the messaging server to the mobile communication device by transmitting the data items from the messaging server to the mobile communication device using an electronic address associated with the mobile communication device; and (D) generating data items at the mobile communication devices and at the desktop systems, wherein the data items generated at the mobile communication devices or the desktop systems are addressed using the e-mail addresses associated with the user accounts as addresses from which the data items originated. Claim 72 includes similar limitations, although drafted in different form.

These new independent claims include steps that are simply missing from the disclosure of Staples. For example, Staples does not disclose the concept of receiving data items that are directed to a plurality of e-mail addresses associated with user accounts maintained by the messaging server. Also, nowhere does Staples refer to the concept of receiving trigger signals to engage redirection of the data items at the messaging server for each of the mobile communication devices, wherein the trigger signal are transmitted from the desktop systems, or from the mobile devices in the case of claim 72. And nowhere does Staples refer to the process of generating data items at

either the mobile communication device or the desktop system which are addressed using the e-mail address of the user account. Because all of these steps are missing from Staples, the new claims are patentably distinguishable from this reference.

Dependent claims 49-71 are distinguishable from Staples for at least the same reasons as claim 48.

5. Conclusion

All of the pending claims are in condition for allowance. There are no outstanding rejections for the Group II Claims. This Amendment has demonstrated that the new claims 48-72 are clearly distinguishable from Staples. Therefore, all of the rejections should be withdrawn, and a notice of allowance is respectfully requested.

Attached hereto is a marked-up version of the changes made to the claims by this Amendment.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims

Please cancel claims 1-10, 15-30 and 42-47.

Please amend the remaining claims as follows:

11. (Amended) [The method of claim 9,] A method of redirecting data items between a host system and one or more mobile communication devices, comprising the steps of:

receiving data items directed to a common address associated with the host system;

configuring one or more redirection events at the host system, wherein the redirection events include external events, internal events or networked events, and wherein the internal event is a calendar alarm;

detecting that a redirection event has occurred at the host system and generating a redirection trigger;

in response to the redirection trigger, continuously redirecting the data items to a mobile communication device; and

receiving data items sent from the mobile communication device;

wherein data items generated at either the host system or the mobile communication device share the common address as an address from which data

items originated.

12. (Amended) [The method of claim 9,] A method of redirecting data items between a host system and one or more mobile communication devices, comprising the steps of:

receiving data items directed to a common address associated with the host system;

configuring one or more redirection events at the host system, wherein the redirection events include external events, internal events or networked events, and wherein the internal event is a screen saver activation;

detecting that a redirection event has occurred at the host system and generating a redirection trigger;

in response to the redirection trigger, continuously redirecting the data items to a mobile communication device; and

receiving data items sent from the mobile communication device;

wherein data items generated at either the host system or the mobile communication device share the common address as an address from which data items originated.

13. (Amended) [The method of claim 9,] A method of redirecting data items between a host system and one or more mobile communication devices, comprising the steps of:

receiving data items directed to a common address associated with the host system;

configuring one or more redirection events at the host system, wherein the redirection events include external events, internal events or networked events, and wherein the internal event is a keyboard timeout signal;

detecting that a redirection event has occurred at the host system and generating a redirection trigger;

in response to the redirection trigger, continuously redirecting the data items to a mobile communication device; and

receiving data items sent from the mobile communication device;

wherein data items generated at either the host system or the mobile communication device share the common address as an address from which data items originated.

14. (Amended) [The method of claim 9,] A method of redirecting data items between a host system and one or more mobile communication devices, comprising the steps of:

receiving data items directed to a common address associated with the host system;

configuring one or more redirection events at the host system, wherein the redirection events include external events, internal events or networked events, and wherein the redirection events further include networked events that include messages to begin redirection from computer systems other than the mobile communication device, which are connected to the host system via a wired network;

detecting that a redirection event has occurred at the host system and

generating a redirection trigger;

in response to the redirection trigger, continuously redirecting the data items to a mobile communication device; and

receiving data items sent from the mobile communication device;

wherein data items generated at either the host system or the mobile communication device share the common address as an address from which data items originated.

35. (Amended) The method of claim 32, wherein the host system is an Internet Service Provider [application service provider].

36. (Amended) The method of claim 32, wherein the host system is a server accessible via the Internet [web-based email server].

37. (Amended) The method of claim 36, wherein the server includes a secure web page for accessing the host system [host system is a web-based personal information manager].

Please add the following new claims 48-72:

-- 48. (New) A method of redirecting data items between a messaging server and a plurality of mobile communication devices, comprising the steps of:

receiving data items directed to a plurality of e-mail addresses associated with user accounts maintained by the messaging server;

for each of the plurality of mobile communication devices, receiving a trigger signal at the messaging server that enables data item redirection, wherein the trigger signals are transmitted to the messaging server from a plurality of desktop systems associated with the plurality of mobile communication devices;

for each of the plurality of mobile communication devices for which a trigger signal has been received at the messaging server, continuously redirecting data items from the messaging server to the mobile communication device by transmitting the data items from the messaging server to the mobile communication device using an electronic address associated with the mobile communication device; and

generating data items at the mobile communication devices and at the desktop systems, wherein the data items generated at the mobile communication devices or the desktop systems are addressed using the e-mail addresses associated with the user accounts as addresses from which the data items originated. --

-- 49. (New) The method of claim 48, further comprising the steps of:

configuring one or more redirection events at each of the desktop systems;

detecting that a redirection event has occurred at one of the desktop systems; and

transmitting the trigger signal from the desktop system where the redirection event was detected to the messaging server. --

-- 50. (New) The method of claim 48, further comprising the step of:

providing a local area network for coupling the plurality of desktop systems to the messaging server. --

-- 51. (New) The method of claim 48, further comprising the step of:

providing a wide are network for coupling the plurality of desktop systems to the messaging server. --

-- 52. (New) The method of claim 48, further comprising the step of:

storing configuration information regarding the plurality of mobile communication devices at the messaging server. --

-- 53. (New) The method of claim 48, wherein the messaging server includes an e-mail server and a redirection program. --

-- 54. (New) The method of claim 52, wherein the configuration information stored at the messaging server includes, for each mobile communication device:

(A) the electronic address of the mobile communication device; and

(B) an indication of the type of mobile communication device. --

-- 55. (New) The method of claim 54, wherein the configuration information stored at the messaging server further includes, for each mobile communication device:

(C) an indication of the types of attachments that the mobile communication device can receive and process. --

-- 56. (New) The method of claim 48, further comprising the step of:

prior to redirecting the data items from the messaging server to the mobile communication devices, packaging the data items into electronic envelopes addressed using the electronic addresses of the mobile communication devices. --

-- 57. (New) The method of claim 48, further comprising the step of:

prior to redirecting the data items from the messaging server to the mobile communication devices, compressing the data items in order to reduce the size of the data items. --

-- 58. (New) The method of claim 48, further comprising the step of:

prior to redirecting the data items from the messaging server to the mobile communication devices, encrypting the data items. --

-- 59. (New) The method of claim 48, further comprising the steps of:

for each data item to be redirected, the messaging server determining whether the data item includes an attachment, and if so, then determining the type of attachment;

determining whether the mobile communication device to which the data item having an attachment is to be redirected can process attachments of the determined type; and

if so, then redirecting the attachments to the mobile communication devices, and if not, then redirecting the attachments to a device that is capable of processing the attachments. --

-- 60. (New) The method of claim 49, wherein the redirection events include internal events, external events or networked events. --

-- 61. (New) The method of claim 60, wherein the internal events include a calendar alarm, a screen saver activation, or a keyboard timeout signal. --

-- 62. (New) The method of claim 60, wherein the external events include a message from the mobile communication device to begin redirection. --

-- 63. (New) The method of claim 48, wherein the mobile communication devices are two-way pagers, hand-held wireless paging computers, cellular telephones having data messaging capabilities, or wirelessly-enabled laptop computer. --

-- 64. (New) The method of claim 48, wherein the mobile communication devices are capable of receiving both voice and data messages. --

-- 65. (New) The method of claim 48, further comprising the step of:

providing a preferred list for each mobile communication device for limiting the redirection step to redirecting only those data items that are transmitted to the messaging server from a sender on the preferred list. --

-- 66. (New) The method of claim 65, wherein the preferred lists are stored at the messaging server. --

-- 67. (New) The method of claim 65, wherein the preferred lists are stored at the desktop systems. --

-- 68. (New) The method of claim 65, further comprising the step of: activating or deactivating the preferred list by transmitting a preferred list activation command from a desktop system to the messaging server. --

-- 69. (New) The method of claim 65, further comprising the step of: activating or deactivating the preferred list by transmitting a preferred list activation command from a mobile communication device to the messaging server. --

-- 70. (New) The method of claim 48, wherein the messaging server is a Microsoft Exchange sever. --

-- 71. (New) The method of claim 48, further comprising the step of:

providing a user profile database at the messaging server that associates particular desktop systems with particular mobile communication devices for a plurality of users. --

-- 72. (New) A method of redirecting e-mail messages between an e-mail messaging server and a plurality of wireless mobile devices, comprising the steps of:

receiving e-mail messages directed to a plurality of e-mail addresses associated with user accounts maintained by the e-mail messaging server;

for each of the plurality of wireless mobile devices, receiving a trigger signal at the messaging server that enables data item redirection, wherein the trigger signals are transmitted to the messaging server from either a plurality of desktop systems associated with the wireless mobile devices or from the wireless mobile devices;

in response to receiving the trigger signals, continuously redirecting the received e-mail messages from the messaging server to the wireless mobile devices using electronic addresses associated with the wireless mobile devices; and

generating e-mail messages at the wireless mobile devices and at the desktop systems, wherein the e-mail messages generated at the wireless mobile devices or the desktop systems are addressed using the e-mail addresses associated with the user accounts as addresses from which the data items originated. --